

REMARKS

Applicants thank the Examiner for the courtesy extended to Applicants' attorney during the interview held May 3, 2004, in the above-identified application. During the interview, Applicants' attorney explained the presently-claimed invention and why it is patentable over the applied prior art, and discussed other issues raised in the Office Action. The discussion is summarized and expanded upon below.

The rejections of Claims 22, 25-30 and 35-40 under 35 U.S.C. § 102(b) as anticipated by, and of Claims 23, 31, and 32 under 35 U.S.C. § 103(a) as unpatentable over, EP0333299 (Coppens), are respectfully traversed. Coppens discloses the addition of chopped bundles of glass or mineral fibers in an amount of 0.2-0.8% by weight, with respect to the mineral constituents in a road paving composition comprising a bituminous binder and such mineral constituents, wherein the length of the filaments is between 5 and 50 mm, and the diameter of the filaments is at least one micrometer. Coppens is concerned with improving of strength characteristics of asphalt layers by adding chopped fibers with an adhesion-promoting protective coating. In Coppens, added fibers are always clearly presented as chopped fibers, and there is no disclosure or suggestion of any flake form or any agglomerating of chopped fibers into any flake form as a result of any operation. On the contrary, the adhesion-promoting protective coating, preferably composed of chemically modified bitumen compositions, is present in order to provide mechanical protection and protection against rubbing and breakage. Contrary to the Examiner's finding, flake formation is not "intrinsic" but is the result of an appropriate operation such as milling (or crushing); furthermore, a special flake shape is also the result of the choice of glass filaments with different diameters, which is nowhere described in Coppens. In addition, in the examples of Coppens, glass fiber monofilaments having a length of approximately 13 mm and a diameter of approximately 13 micrometers are used.

Thus, Coppens neither discloses nor suggests the presently-claimed subject matter. In addition, the dependent claims are separately patentable, particularly those reciting a particular E-type glass, such as Claim 23, and Claim 41, which recites filaments from two different yarns, one having a diameter of less than 10 micrometers, and one having a diameter of greater than 14 micrometers. While the Examiner relies herein on the disclosure in the specification at page 5, lines 19-21 that E-glass is known to have a number of superior properties, it is **Applicants'** discovery, not that of the prior art, that such properties would be useful in the present invention. Compare *In re Ruff*, 118 USPQ 340, 347 (CCPA 1958) (copy of record) ("To rely on an equivalence *known only to the applicant* to establish obviousness is to assume that his disclosure is a part of the prior art. The mere statement of this proposition reveals its fallaciousness.")

In accordance with the Interview Summary for the above-referenced interview, the Examiner states that a statement in a declaration "that such flakes would not inherently result from 'chopping' as done to create bundles in the prior art would obviate the outstanding art rejection." In reply, the newly-submitted Ghiretti Declaration provides such a statement.

For all the above reasons, it is respectfully requested that the rejections over Coppens be withdrawn.

The rejection of Claims 22-41 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enable requirement thereof, is respectfully traversed. In the Interview Summary for the above-referenced interview, the Examiner states that a declaration "stating that one of ordinary skill in the art would understand how to make 'flakes' upon milling of the yarns would obviate" this rejection. The newly-submitted Ghiretti Declaration provides such a statement. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 28 and 33 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Indeed, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that it be withdrawn.

Applicants note again that the present Office Action Summary page, as well as the Office Action Summary page of the previous Office Action, does not indicate whether or not the drawings have been accepted. Have they been accepted?

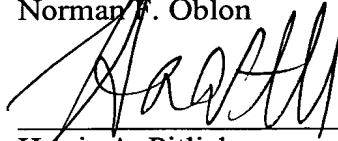
Applicants respectfully traverse the finality of the Office Action. The above-discussed rejection under 35 U.S.C. § 112, first paragraph, appears to be based on Applicants' argument that flake formation is not intrinsic herein. However, there is no precedent for making an Office Action final which contains a new ground of rejection that was not necessitated by an **amendment to the claims**, as opposed to an argument. Accordingly, if the present amendment does not result in a Notice of Allowance, then the Examiner is respectfully requested to enter the amendment as a matter of right.

All of the presently pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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